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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,017	12/21/2001	Brian S. Huffman	1749	8387

7590 06/15/2005

Cynthia L. Foulke
NATIONAL STARCH AND CHEMICAL COMPANY
10 Finderne Avenue
Bridgewater, NJ 08807-0500

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,017

Applicant(s)

HUFFMAN ET AL.

Examiner

Rabon Sergeant

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-23, 25, 26 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22, 23 and 25 is/are allowed.
- 6) ☒ Claim(s) 17-21, 26, and 28-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 21, 2005 has been entered.
2. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The subject matter of claim 19 fails to further limit claim 32, because the species at the bottom of page 6 of the amendment and the alkenyl species at the top of page 9 of the amendment are not within the definition of R of claim 32 (these species exceed 17 carbon atoms and the species on page 9 is unsaturated).

3. Claims 17-21, 26, and 28-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have failed to provide support for embodiments wherein the R group is a trimer derived from p-phenylene diisocyanate. Applicants have disclosed that the R groups may not be derived from p-phenylene diisocyanate (see page 5, lines 10 and 11 of specification) and no indication has been provided that trimers of p-phenylene diisocyanate are excluded from this requirement; however, applicants' claims encompass a compound derived from such an R group.

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4. Claims 17-21, 26, and 28-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants have failed to provide enablement for compounds derived from trimers of p-phenylene diisocyanate. Since applicants specifically disclose that the R group may not be derived from such a compound, it follows that adequate enablement for the production of such a compound is lacking. Therefore, in the absence of adequate guidance for the production of such a compound, the position is taken that one of ordinary skill in the art could not practice the invention without having to resort to undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed Cir. 1988).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 17 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by See et al. ('951) or Leslie-Smith et al. (Divergent Behavior in the Isocyanate-induced and Thermal Generation of Nitrile Oxides from Ethyl Nitroacetate) or Boyd et al. (The Reactions of Aliphatic Nitro Compounds: Condensations with Isocyanates) or Shimizu et al. (Synthesis of Isoxazoline-3-carboxanilides and Isoxazole-3-carboxanilides by Thermolysis of Methoxycarbonyl-nitroacetanilides in the Presence of Dipolarophiles) or Prep'yalov et al. (Reaction of 2-substituted 6-alkoxy-4H-1,3-oxazin-4-ones with some electrophilic and nucleophilic agents).

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The references disclose nitrile oxide precursors which correspond to those claimed. See column 36, line 13 and compound 201 within See et al. See line 3 of page 9252 of Leslie-Smith et al. See page 2762 of Boyd et al. See page 488 of Shimizu et al. See CAS registry number 176100-72-4 of Prep'yalov et al.

7. The references were made of record and supplied during prosecution of the parent application.

8. Claims 22, 23, and 25 are allowable over the prior art of record.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
June 13, 2005


RABON SERGENT
PRIMARY EXAMINER